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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/598,000	08/15/2006	Andrei Mijiritskii	NL 040146	8973
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EXAMINER				
HIGGINS, GERARD T				
ART UNIT		PAPER NUMBER		
1794				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/598,000

Applicant(s)

MIJIRITSKII ET AL.

Examiner

GERARD T. HIGGINS

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-23 is/are pending in the application.
- 4a) Of the above claim(s) 22 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/17/2009 has been entered.

Response to Amendment

2. Applicant's amendment filed 04/17/2009 has been entered. Currently claims 15-23 are pending, claims 1-14 are cancelled, and claims 15-23 are new.

Election/Restrictions

3. Newly submitted claims 22 and 23 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the label recording device does not require the special technical features of the optical disc according to claim 15, including two label material layers and a mixed label layer, and therefore the inventions lack unity; furthermore, the label recording device is distinct from the optical disc of claim 15 because the inventions are mutually exclusive, are not obvious variants, and have a materially different design.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 22 and 23 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

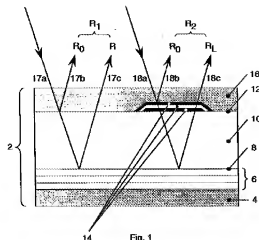
Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan et al. (5,510,163) in view of either of Anderson et al. (US 2003/0108708) or Lawandy et al. (US 2003/0012562).

With regard to claim 15, Sullivan et al. disclose the optical recording medium of Figure 1.



The device is comprised of a substrate **10** and a logo coating **14**, which together read on applicants' transparent layer, and a recording coating **6**, which reads on applicants' at least one data layer (col. 6, lines 4-21). The data in the recording coating is retrievable through the transparent layer as can be seen by the arrows in the Figure, and additionally as stated at col. 5, lines 6-45. The logo coating may comprise multiple layers as seen in the Figure, which reads on applicants' requirement that the transparent layer comprise two label material layers (col. 8, lines 7-11). The logo coating may comprise organic dyes, which read on applicants' label material, and with multiple layers the logo coating may be designed with a particular color (col. 8, lines 11-17). The Examiner deems that this disclosure teaches using different organic dyes, i.e. different label materials having different absorption spectra; otherwise it would not be possible to form a multilayered logo coating of a particular color.

Alternatively, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use different organic dyes having different absorption spectra in the multilayered logo coating in order to make the logo coating

more difficult to counterfeit and therefore more secure as taught by Sullivan et al. at col. 8, lines 15-17.

With regard to the limitation "for affecting reflection or absorption using laser beams at different wavelengths," while there is no disclosure that the organic dyes have the ability "for affecting reflection or absorption using laser beams at different wavelengths" as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that "if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction". Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use, i.e. "for affecting reflection or absorption using laser beams at different wavelengths," recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art logo coating and further that

the prior art structure which is a multilayered label material layer identical to that set forth in the present claims is capable of performing the recited purpose or intended use.

The Examiner also notes that the logo coating of Sullivan et al. is preferentially affected using light in the visible spectrum (col. 8, lines 11-13). Given the fact that the Examiner has taught using multiple logo coating layers of different materials having different colors, i.e. absorption spectra, this provides further evidence that the organic dye logo coatings may be affected using laser beams of different wavelengths; however, Sullivan et al. fail to teach a mixed label layer at another side of the optical disc, wherein the at least one data layer is between the transparent layer and the mixed label layer.

Anderson et al. teach an integrated CD/DVD recording and labeling disc (Abstract). There may be a laser-sensitive layer, which reads on applicants' mixed label layer, provided on the opposite side of the optical disc from the read/write side [0025], [0087], and Figure 3. The laser-sensitive layer may include microcapsule materials comprising encapsulated dye particles [0085], which read on applicants' label material dispersed in a substrate. The Examiner deems that these encapsulated materials will be dispersed throughout the laser-sensitive layer; otherwise it would not be possible to form an image anywhere in the laser-sensitive layer as is implicitly suggested at [0024] and [0025].

Lawandy et al. disclose at [0078] that a label material may be dispersed in a polymer matrix. Lawandy et al. disclose in a preferential embodiment that there coating

may be placed on the read side of the optical information medium; however, they are not limiting their invention to such an embodiment [0037].

Since Sullivan et al., Anderson et al., and Lawandy et al. are all drawn to label coatings for optical recording media; it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine either of the coatings of Anderson et al. or Lawandy et al. on the opposite side from the read/write side of the optical disc of Sullivan et al. The results of such a combination would have been predictable; further, each of the elements would have performed the same in combination as they had separately. The motivation to place it on the opposite side of the article is to establish the authenticity of the article as suggested by Lawandy et al. [0039] or to provide a customizable label as suggested by Anderson et al. [0002].

With regard to claim 16, the Examiner regards the limitations of this claim as intended use limitations of the optical disc of claim 15, which are not dispositive of patentability. Additionally, the Examiner interprets "a user of an optical disc" to be anyone, including persons who are involved in the manufacture of the optical disc. As such it is clear that during the manufacture of said optical disc prior to writing label information on said logo coatings **14**, the logo coatings will be provided to the person who writes information into said logo coatings; hence Sullivan et al. disclose providing an optical disc that does not have label information therein.

With regard to claim 17, Figure 1 shows logo coatings that are directly upon each other as claimed.

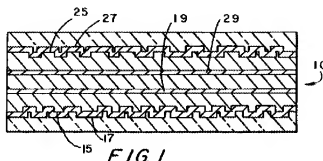
With regard to claim 18, the Examiner deems this to be a mere duplication of parts of the multilayered logo coating **14** and the protective layer **16** on top of the already existing protective coating **16**. It has been held that "mere duplication of parts has no patentable significance unless a new and unexpected result is produced." Please see MPEP 2144.04 and *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). In this sense there would not be any new and unexpected result produced as the duplication of the multilayered logo coating **14** and the protective layer **16** would produce a label with an even more intricate design as well as 3-dimensional effects of the label. This would also serve to further increase the difficulty in counterfeiting the logo coating.

With regard to claim 19, the duplication of parts rendered obvious above would provide a protective coating **16** on the outer surface of the optical disc, which would then read on applicants' upper substrate layer at an outer surface of the optical disc located over one of the two label material layers.

6. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan et al. (5,510,163) in view of either of Anderson et al. (US 2003/0108708) or Lawandy et al. (US 2003/0012562) as applied to claim 15, and further in view of Yurescko-Suhan (5,792,538).

Sullivan et al. in view of either of Anderson et al. or Lawandy et al. render obvious all of the limitations of applicants' claim 15 in section 5 above; however, they do not disclose two data layers separated by a substrate layer.

Yurescko-Suhan discloses an optical disc as in their Figure 1.



The optical disc comprises two data layers **15** and **25** that are separated by various layers, including layers analogous to the layer **13** of Figure 2 (col. 2, lines 18-22). Although these layers are not specifically named, the Examiner deems these layers to read on the substrate layer that separates the two data layers. Yurescko-Suhan's optical disc may comprise multiple label layers **19** and **29** (col. 2, lines 21-22).

Since Sullivan et al., Anderson et al., Lawandy et al., and Yurescko-Suhan are drawn to optical discs comprising multiple label layers; it would have been obvious to one having ordinary skill in the art to incorporate two data layers separated by a substrate layer as taught by Yurescko-Suhan into the disc structures with the label layer placements of Sullivan et al. in view of either of Anderson et al. or Lawandy et al. The resulting structure would have two data layers and a substrate layer separating the data layers located in between the substrate **10** and the logo coating **14** on one side of the optical disc structure and also the dispersed label material in a matrix on the other side of the optical disc structure. The motivation for including multiple data layers is to increase the storage capacity of the optical disc and the motivation to include a

substrate layer in between said multiple data layers in to prevent crosstalk when recording to each of the data layers because the data layers will be at different focal distances.

With regard to claim 21, Sullivan et al. teach in Figure 8 and at col. 9, lines 52-67 that the logo coating may be applied on, under, within, or next to the recording coating of their optical recording medium. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have one of the data layers in direct contact with the mixed label layer and also to have one of the label material layers in direct contact with the other of the data layers. Sullivan et al. teach a logo coating in direct contact with the recording layer, and it would have been obvious to one having ordinary skill to extent this concept to the label layers of Sullivan et al. in view of either of Anderson et al. or Lawandy et al. and further in view of Yurescko-Suhan.

Response to Arguments

7. Applicant's arguments with respect to claims 1-6 and 14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Examiner has cited US 5,509,991 which teaches placing a label material into a reflective layer see Figures 2D and 3E and section 8 above, US 6,778,205 which teaches a label layer **302** which can include a thermally sensitive layer

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306 wherein the thermally sensitive layer may include a plurality of layers (Figure 3A and col. 5, lines 29-39).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GERARD T. HIGGINS whose telephone number is (571)270-3467. The examiner can normally be reached on M-Th 10am-8pm est. (Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Bernatz, acting SPE for Carol Chaney, can be reached on 571-272-1505. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin M Bernatz/
Acting SPE of Art Unit 1794
May 30, 2009

GERARD T. HIGGINS
Examiner
Art Unit 1794

/G. T. H./
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